

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference GOOGPP018WO	FOR FURTHER ACTION	See item 4 below
International application No. PCT/US2004/043976	International filing date (<i>day/month/year</i>) 30 December 2004 (30.12.2004)	Priority date (<i>day/month/year</i>) 31 December 2003 (31.12.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant GOOGLE INC.		

1.	This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 <i>bis</i> .1(a).																								
2.	<p>This REPORT consists of a total of 8 sheets, including this cover sheet.</p> <p>In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.</p>																								
3.	<p>This report contains indications relating to the following items:</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 10%; text-align: center;"><input checked="" type="checkbox"/></td> <td style="width: 30%;">Box No. I</td> <td style="width: 60%;">Basis of the report</td> </tr> <tr> <td style="text-align: center;"><input checked="" type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td style="text-align: center;"><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>	<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input checked="" type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input type="checkbox"/>	Box No. VIII	Certain observations on the international application
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4.	The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).																								

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 03 July 2006 (03.07.2006) Authorized officer <p style="text-align: center; font-weight: bold;">Agnes Wittmann-Regis</p> e-mail: pt06@wipo.int
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PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

REC'D 21 APR 2005

WIPO

PCT

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To:

see form PCT/ISA/220

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing

(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference

see form PCT/ISA/220

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/US2004/043976

International filing date (day/month/year)

30.12.2004

Priority date (day/month/year)

31.12.2003

International Patent Classification (IPC) or both national classification and IPC

G06F17/27, G06F17/30

Applicant

GOOGLE INC.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2004/043976

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

Box No. II Priority

1. ☒ The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43*bis*.1 and 64.1) is the claimed priority date.
2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2004/043976

Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1,11,20
Inventive step (IS)	Yes: Claims	
	No: Claims	2-10,12-19,21-28
Industrial applicability (IA)	Yes: Claims	1-28
	No: Claims	

2. Citations and explanations

see separate sheet

Re Item V

Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. The application does not meet the requirements of Article 6 PCT, because claims 1, 4, 11, 13 and 20 are not clear.
 - 1.1. Claim 1 does not meet the requirements of Article 6 PCT in that the matter for which protection is sought is not defined. The claim attempt to define the subject-matter in terms of the result to be achieved which merely amounts to a statement of the underlying problem ("locating a text reference in a source document" - how is it located? And "identifying a target document relating to the text reference" - how is it identified?). The technical features necessary for achieving this result should be added. The subject-matter added by claims 2, 3 might help for clarification.

This also applies to claims 11 and 20. The subject-matter added by claims 12 and 21 might help for clarification respectively.

Furthermore, independent claims in different categories should claim corresponding features in corresponding terms. Currently, claims 1, 11 and 20 do not yet fully conform but define not corresponding sets of features, making not clear which are the essential features of the invention for which protection is sought, and thereby rendering said claims unclear. Claims 11 and 20 should be drafted in order to conform to claim 1.

- 1.2. Claim 4 does not meet the requirements of Article 6 PCT in that the matter for which protection is sought is not defined. The claim attempt to define the subject-matter in terms of the result to be achieved which merely amounts to a statement of the underlying problem ("locating a label ..." - how is it located?). The technical features necessary for achieving this result should be added. The subject-matter added by claim 5 might help for clarification.

The same applies to claims 13 and 22. The subject-matter added by claims 14 and 23 might help for clarification respectively.

2. The following comments are made under the assumption that clarified claims will be submitted.
3. The following documents (D) are referred to in this communication; the numbering will be adhered to in the rest of the procedure:
 - D1: US6122647
 - D2: WO0043918
 - D3: US5815830
 - D4: WO02061627
 - D5: US6256631
 - D6: US5794257
 - D7: EP0810534
 - D8: XP000308936
 - D9: GB2368167
 - D10 US5708825
4. The subject-matter of the independent claims does not seem novel over prior art document D1 (see D1 at the abstract, the summary, Figures 3, 4c, 4d, 6-8 and their descriptions). The features added by the dependent claims are either known from D1 or form part of the general knowledge of the person skilled in the art. They do not appear to comprise anything which would go beyond the prior art to an extent that it could be considered as involving an inventive step.
5. Furthermore, notwithstanding what has been said above, the subject-matter of the independent claims does not seem to be new over prior art document D2 (see D2 at the abstract, the summary, Figures 2 and 3 and their descriptions). The features added by the dependent claims are either known from D2 or form part of the general knowledge of the person skilled in the art. They do not appear to comprise anything which would go beyond the prior art to an extent that it could be considered as involving an inventive step.

The same applies in view of D3 (see D3 at the abstract, the summary, Figures 1, 4 and 5 and their descriptions), in view of D4 (see D4 at the abstract, the summary, Figures 1-4 and their descriptions), in view of D5 (see D5 at the abstract, the

summary, Figures 3-4 and their descriptions), in view of D6 (see D6 at the abstract, the summary, Figures 1 and 3-4 and their descriptions), in view of D7 (see D7 at the abstract, the summary, Figures 7, 14-15, 19, 22-26 and their descriptions), and also in view of D8.

The same applies in view of D9 (see D9 at the abstract, the summary, Figures 1 and 6 and their descriptions) and also in view of D10 (see D10 at the abstract, the summary, Figures 5A, 5B, 8 and 9A and their descriptions, in particular c.9 l.26-45).

6. It is not at present apparent which part of the application could serve as a basis for a new claim which might meet the requirements of the PCT. If the applicant nevertheless regards some particular matter as meeting the requirements of the PCT, it would appear appropriate to file new claims which take account of the above comments. The applicant might also indicate in the letter of reply the difference of the subject-matter of the new claim vis-à-vis the state of the art and the significance thereof, in particular the technical effect provided by said difference. He should further explain what he thinks is the objective technical problem to be solved in view of the closest prior art (based on the effect provided by differences), i.e. the aim and task of modifying or adapting the prior art to provide this identical technical effect, and where he sees any inventive step in the solution, i.e. why such a modification would not be obvious to the person skilled in the art, taking into account the prior art and the common general knowledge of the person skilled in the art. When doing so, the following should be considered:
 - 6.1. The features of the claims are not provided with reference signs placed in parentheses (Rule 6.2(b) PCT).
 - 6.2. The independent claims are not in the two-part form in accordance with Rule 6.3(b) PCT, which in the present case would be appropriate, with those features known in combination from the closest prior art being placed in the preamble (Rule 6.3(b)(i) PCT) and with the remaining features being included in the characterising part (Rule 6.3(b)(ii) PCT).

The independent claims should therefore be redrafted accordingly. If, however, the applicant is of the opinion that the two-part form would be inappropriate, then reasons

therefor should be provided in the letter of reply. In addition, the applicant should ensure that it is clear from the description which features of the subject-matter of the independent claims are already known in combination from the prior art mentioned above (see the PCT Guidelines, III-2.3a).

- 6.3. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the documents D1-D5 is not mentioned in the description, nor are these documents identified therein.
- 6.4. The description is not in conformity with the claims as required by Rule 5.1(a)(iii) PCT. The summary of the invention should explicitly refer to the independent claims and mention their category.
- 6.5. When revising the claims, the applicant may not add subject-matter which extends beyond the content of the application as originally filed (Art. 19(2), 34(2)(b) PCT).
- 6.6. In order to facilitate the examination of the conformity of the amended application with the requirements of Article 34(2)(b) PCT, the applicant is requested to clearly identify the amendments carried out, no matter whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based (see also Rule 66.8(a) PCT). Replacement pages should be filed for only those pages which have been amended. Unnecessary recasting of the description should be avoided. An amended abstract is not required.
The applicant is requested to file amendments by way of replacement pages in the manner stipulated by Rule 66.8(a) PCT.
- 6.7. Moreover, the applicant's attention is drawn to the fact that, as a consequence of Rule 66.8(a) PCT the examiner is not permitted to carry out any amendments under the PCT procedure, however minor these may be.
- 6.8. The vague generalising expression spirit in the description at page 3, line 32, and at page 10 line 11, brings into doubt the subject matter for which protection is actually sought, and should therefore be deleted.